

ESTTA Tracking number: **ESTTA661457**

Filing date: **03/16/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057023
Party	Plaintiff LuckyU Enterprises, Inc., dba Giovanni's Original White Shrimp Truck
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Attachments	Petitioner's Brief Redacted.pdf(132988 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 4,220,686
Mark: GIOVANNI'S ALOHA FOODS
Registration date: October 9, 2012

In the matter of Trademark Registration No. 4,224,400
Mark: GIOVANNI'S SCAMPI MARINADE
Registration date: October 16, 2012

In the matter of Trademark Registration No. 4,232,569
Mark: GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK
Registration date: October 30, 2012

In the matter of Trademark Registration No. 4,248,595
Mark: GIOVANNI'S HOT & SPICY WE REALLY MEAN IT! SAUCE
Registration date: November 27, 2012

LuckyU Enterprises, Inc., dba Giovanni's	:	
Original White Shrimp Truck	:	
	:	
Petitioner,	:	
	:	
v.	:	Cancellation No. 92057023
	:	
John "Giovanni" Aragona	:	Redacted Version
	:	
Respondent.	:	

PETITIONER'S BRIEF

(Non-Confidential Version)

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I. PRELIMINARY STATEMENT

John Aragona (“Registrant”) was a onetime food truck owner, who, along with his then wife, Connie Aragona, sold sautéed shrimp from a food truck located on the North Shore of Hawaii. Registrant and his wife sold this fledgling business more than a decade ago, well before filing the applications subject to this proceeding. The business was sold to Nitsche Enterprises, Inc. in 1997 under an Asset Purchase Agreement. Petitioner, LuckyU Enterprises, the successor in interest of Nitsche Enterprises, Inc. for the purchased restaurant business, acquired all rights to the shrimp truck business.

Soon after Petitioner acquired the food truck business, Registrant, his wife, and other partners, started a Limited Liability Company, Giovanni’s Aloha Foods, a Hawaii Company (“the Hawaii LLC”), devoted to selling sauces to the shrimp truck. Petitioner agreed to purchase the sauces from the Hawaii LLC as long as the Hawaii LLC could deliver the sauces. Along with Registrant and his wife, Jim Goodrich, a member of Petitioner, was also an original member of the Hawaii LLC. The Hawaii LLC struggled and the members eventually approached Troy Nitsche and offered him equity in the sauce bottling business in exchange for an investment of \$100,000. Mr. Nitsche agreed to become a member of the Hawaii LLC. Soon after Mr. Nitsche joined the business, Registrant and his then wife Connie Aragona divorced and Registrant left the State of Hawaii, ceasing participation in the business. The Hawaii LLC continued to operate until 2004. The shrimp truck business has continued to operate up through today under the names GIOVANNI’S ALOHA SHRIMP, GIOVANNI’S ORIGINAL WHITE SHRIMP TRUCK and GIOVANNI’S SHRIMP TRUCK (“Petitioner’s GIOVANNI’S marks”).

Nitsche Enterprises, and later in conjunction with Mr. Goodrich, as LuckyU Enterprises, managed to turn Mr. Nitsche’s \$120,000 investment in two food trucks into [REDACTED]

■■■■ a year business. The business thrived as Mr. Nitsche devoted significant resources to marketing. The business has been featured on television shows and is generally well-known throughout the United States and around the globe.

The Hawaii LLC did not fare as well and Connie Aragona eventually decided to try to “take back” the shrimp truck business. Mrs. Aragona threatened Mr. Nitsche and his family unless he agreed to sign over the food truck business he purchased from her in 1997. Mrs. Aragona was convicted for these actions in 2003. She is still serving a twenty year sentence. Only Mr. Nitsche, Mr. Goodrich, and Mr. Goodrich’s wife, Diana, remained as active members of the Hawaii LLC. In 2004, the membership agreed to dissolve the bottling and distribution of the shrimp sauces. LuckyU Enterprises continued to focus on running the shrimp truck business.

LuckyU Enterprises as successor in interest of Nitsche Enterprises and the Hawaii LLC, has been continuously providing restaurant services in connection with the sale of shrimp and related food from its food trucks since 1997 under GIOVANNI’S ALOHA SHRIMP and GIOVANNI’S SHRIMP TRUCK. In March of 1998, Petitioner also began using GIOVANNI’S ORIGINAL WHITE SHRIMP TRUCK in commerce for its restaurant and food truck services. Further, Petitioner sells sautéed shrimp dishes, including a shrimp scampi and shrimp hot and spicy from the truck under the mark GIOVANNI’S ORIGINAL WHITE SHRIMP TRUCK.

Registrant was fully aware that Petitioner uses the above referenced trademarks, and further that Petitioner acquired the rights under the Asset Purchase Agreement to operate and expand the business including any trademarks associated with the food truck business, Registrant still elected to file trademark applications for GIOVANNI’S ORIGINAL WHITE SHRIMP TRUCK, GIOVANNI’S ALOHA FOODS, GIOVANNI’S SCAMPI MARINADE, and GIOVANNI’S HOT & SPICY WE REALLY MEAN IT! SAUCE (“Registrant’s GIOVANNI’S

marks”). In support of some of these applications, Registrant used relatively recent pictures of *Petitioner’s* trucks, food and advertising as specimens, and Registrant filed for nearly identical trademarks as those used by the Hawaii LLC (now dissolved). Based on the evidence and testimony provided by Registrant, Registrant admits that he does not offer “food preparation services” or “mobile restaurant services” despite the claims in his applications and subsequently issued registrations under the marks GIOVANNI’S ALOHA FOODS and GIOVANNI’S ORIGINAL WHITE SHRIMP TRUCK. Further, the evidence shows only limited sales of bottled scampi and hot sauce starting as late as 2009, well after LuckyU Enterprises, Nitsche Enterprises, or the Hawaii LLC Giovanni’s Aloha Foods had established use of similar trademarks for related goods/services. The sale of a shrimp scampi marinade, shrimp sauté hot sauce, and retail food services under Registrant’s GIOVANNI’S marks are likely to cause consumer confusion with *Petitioner’s* marks and have caused confusion in violation of 15 U.S.C. § 1052(d). Further, Registrant’s registration for GIOVANNI’S ORIGINAL WHITE SHRIMP TRUCK is *void ab initio* because the mark was not in use by Registrant at the time of application and has not been used by Registrant. Registrant’s trademarks and use thereof falsely suggest a connection with *Petitioner* and are deceptive. Registrant has further abandoned the trademarks and committed fraud in procuring the registrations. Accordingly, LuckyU Enterprises, dba Giovanni’s Original White Shrimp Truck, a Hawaii Corporation (“*Petitioner*” or “*LuckyU*”), has petitioned to cancel John Aragona’s (“*Registrant*” or “*Aragona*”) registrations for the following GIOVANNI’S marks:

- GIOVANNI'S ALOHA FOODS, Registration No. 4,220,686 for “food preparation services” in class 43, issued October 9, 2012;
- GIOVANNI'S SCAMPI MARINADE, Registration No. 4,224,400 for “marinades” in class 30, issued October 16, 2012;

- GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK, Registration No. 4,232,569 for “mobile restaurant services” in class 43, issued October 30, 2012; and
- GIOVANNI'S HOT & SPICY WE REALLY MEAN IT! SAUCE, Registration No. 4,248,595 for “hot sauce” in class 30, issued November 27, 2012.

II. DESCRIPTION OF THE RECORD

The evidence of record consists of evidence introduced by Petitioner, evidence introduced by Registrant, and various testimony depositions.

The following evidence was submitted in the Petitioner’s Notice of Reliance (PNOR)¹;

<u>Description:</u>	<u>Exhibit</u>
<ul style="list-style-type: none"> • Registrant’s registrations at issue in this case and the accompanying file histories. Registration Nos. 4,220,686; 4,232,569; 4,248,595; 4,224,400 	Exh. 1 ²
<ul style="list-style-type: none"> • Petitioner’s Applications asserted in Cancellation No. 92057023. Application Serial Nos. 85/897,872; 85/897,861 	Exh. 2
<ul style="list-style-type: none"> • Petitioner’s Applications abandoned in 2012, and the accompanying file histories. Application Nos. 85/219,370; 85/219,363; 85/201,288; 85/201,288 and 85/201,283 	Exh. 2
<ul style="list-style-type: none"> • Various article, advertisements, and Printed Publication excerpts 	Exh. 3
<ul style="list-style-type: none"> • Registrant’s Objections and Responses to Petitioner’s Requests for Admissions 	Exh. 4
<ul style="list-style-type: none"> • Registrant’s Objections and Responses to Petitioner’s Interrogatories 	Exh. 5
<ul style="list-style-type: none"> • Registrant’s Supplementary Responses to Petitioner’s Interrogatories 	Exh. 5
<ul style="list-style-type: none"> • Documents produced by Registrant during discovery by 	Exh. 6

¹ Petitioner refers to documents in PNOR and PRNOR by document production numbers in the format LuckyU00000X, for Petitioner-produced documents, or JA00000X, for documents produced by Registrant.

² Petitioner timely filed a Supplemental Notice of Reliance which included the missing file history for Registration No. 4,248,595.

- | | |
|--|---------------------------------------|
| stipulation of the parties | (confidential) |
| • Excerpts from the John Aragona discovery deposition transcript pursuant to the Trademark Rules | Exh. 7 ³
(confidential) |
| • Stipulations by the parties | Exh. 8 |
| • Web page print-outs | Exh. 9 |

The following evidence was submitted in the Respondent's Notice of Reliance (RNOR):

- | <u>Description:</u> | <u>Exhibit</u> |
|--|----------------|
| • Various articles, advertisements, and Printed Publication excerpts | Exh. A |
| • Official Records as described in 37 CFR § 2.122(e) | Exh. B |
| • Petitioner's Responses to Registrant's Requests for Admissions | Exh. C |
| • Petitioner's Responses to Registrant's Interrogatories | Exh. C |
| • Web page print-outs | Exh. D |
| • Excerpts from the John Aragona discovery deposition transcript pursuant to the Trademark Rules | Conf. Exh. E |
| • Stipulations by the parties | Conf. Exh. F |

The following evidence was submitted in the Petitioner's Rebuttal Notice of Reliance (PRNOR):

- | <u>Description:</u> | <u>Exhibit</u> |
|--|--------------------------|
| • Excerpts from the John Aragona discovery deposition transcript pursuant to the Trademark Rules | Exh. 1
(confidential) |
| • State of Hawaii Department of Commerce and Consumer Affairs Official Records | Exh. 2 |

The parties entered into the following stipulations:

³ Petitioner will refer to this deposition as Aragona DD. The Deposition was marked Trade Secret/Commercially Sensitive in its entirety.

- (1) The parties stipulate to the authenticity of the third-party e-mails produced by Respondent to date in this proceeding. The parties reserve the right to all other objections to the documents (TTABVue #14).
- (2) Respondent stipulates that all the information in the applications for the registrations at issue was provided by John Aragona to his attorney and application signatory, Jamie Pitts. Jamie Pitts signed declaration reflects only the knowledge she received directly from John Aragona (TTABVue # 15)

The parties submitted the following testimony deposition transcripts and accompanying exhibits:

- Troy Nitsche (“Nitsche TD1”) taken on September 17, 2014⁴
- Alex Sonson (“Sonson TD”) taken on December 3, 2014⁵
- Troy Nitsche (“Nitsche TD2”) taken on December 3, 2014⁶
- John Aragona (“Aragona TD”) taken on December 11, 2014⁷

III. STATEMENT OF THE ISSUES

1. Whether Registrant’s registrations for Registrant’s GIOVANNI’S marks should be cancelled under 15 U.S.C. § 1052(d) because they are likely to cause confusion with Petitioner’s earlier and existing Petitioner’s GIOVANNI’S marks.
2. Whether Registrant’s registrations for Registrant’s GIOVANNI’S marks should be cancelled under 15 U.S.C. § 1052(a) because they falsely suggest a connection with Petitioner.
3. Whether Registrant’s registrations for Registrant’s GIOVANNI’S marks should be cancelled under 15 U.S.C. § 1052(a) because they are being used by Registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used and are deceptive.
4. Whether Registrant’s registration for GIOVANNI’S ORIGINAL WHITE SHRIMP TRUCK mark should be cancelled as *void ab initio* because it was not in use on or in connection with the recited goods at the time the application was filed.
5. Whether Registrant’s registrations for Registrant’s GIOVANNI’S marks should be cancelled under 15 U.S.C. § 1064(3) because Registrant abandoned the marks.

⁴ The first Troy Nitsche Testimony Deposition will be referred to as Nitsche TD1.

⁵ The Alex Sonson Testimony Deposition will be referred to as Sonson TD.

⁶ The second Troy Nitsche Testimony Deposition will be referred to as Nitsche TD2.

⁷ The John Aragona Testimony Deposition will be referred to as Aragona TD.

6. Whether Registrant's registrations for Registrant's GIOVANNI'S marks should be cancelled due to Registrant's fraud on the PTO in procuring the registrations.

IV. **RECITATION OF FACTS**

A. **Petitioner's Priority and Renown of GIOVANNI'S in Relation to Food Services**

LuckyU Enterprises and its predecessors in interest, Nitsche Enterprises and Giovanni's Aloha Foods, a Hawaii LLC (collectively "LuckyU") have been selling shrimp plate lunches, drinks, restaurant services, and other food service items out of mobile food trucks for over 17 years when Nitsche Enterprises purchased a business owned by John and Connie Aragona. Nitsche TD1 13:1-14-3. The business purchased by Nitsche Enterprises included two trucks, signage and all of the equipment to run the business formerly owned by John and Connie Aragona. Petition for Cancellation at Appendix A; Nitsche 38:24-39:16; [REDACTED]. The word "Giovanni's" was prominently displayed on the purchased trucks and signage. Nitsche TD1 41:3-13; Nitsche TD1 58:5-11. Petitioner is the owner of GIOVANNI'S ALOHA SHRIMP, GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK, and GIOVANNI'S SHRIMP TRUCK. Nitsche TD1 9:11-25.

Nitsche Enterprises purchased the trucks and immediately began selling shrimp and other retail food products under the trademarks GIOVANNI'S SHRIMP TRUCK and GIOVANNI'S ALOHA SHRIMP. Nitsche TD1 24:21-25:3; Nitsche TD1 53:20-54:9; Nitsche TD1 at Exs. 2, 3, and 5; PNOR Ex. 3. Shortly after purchasing the business and in the face of competition from other food trucks selling shrimp in the area, Nitsche Enterprises started using the mark GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK to further distinguish its business from its competitors and reinforce that his business was the ORIGINAL. Nitsche TD1 10:16-24; Nitsche TD1 54:12-55:4. In the 17 years since acquiring the business, Petitioner has substantially exclusive & continuous use of the marks and no other food truck has used a similar

GIOVANNI’S trademark. Nitsche TD1 55:5-8. Mr. Nitsche also sells GIOVANNI’S SCAMPI and GIOVANNI’S HOT & SPICY shrimp plates. Nitsche TD1 64:6-8; Nitsche TD1 at Ex.8; see also Petition for Cancellation. Nitsche Enterprises continuously sold food and drink from its food trucks, including shrimp plates, until 2003 or 2004 when it was reformed under LuckyU Enterprises dba Giovanni’s Original White Shrimp Truck and all assets of Nitsche Enterprises were transferred to the new company. Nitsche TD1 53:3-16. Registrant has admitted to Petitioner’s continued use of the marks. See Answer at ¶ 9. Petitioner’s substantially exclusive and continuous use of the GIOVANNI’S marks are distinctive, and Petitioner has come to be known under the marks, the marks have acquired secondary meaning, and are associated with Petitioner. Petitioner is the true owner of the trademarks.

The Hawaii LLC was formed in 1998 (See Aragona TD at Exhibit 15) with the primary focus being “[t]he manufacture and sale of the LLC’s bottled sauces and bottling of third party products.” Nitsche TD2 at Ex. 5. Troy Nitsche entered the LLC as a member on October 14, 1999. Pursuant to the Hawaii LLC operating agreement, John and Connie Aragona contributed their sauce recipes, existing business contracts, and certain production equipment valued at \$15,000. Jim Goodrich and Diana Wong contributed \$3,000, their business expertise and legal services. Troy Nitsche contributed \$100,000. Nitsche TD2 at Ex. 5. There were three voting interests; John and Connie Aragona had one vote, Jim Goodrich and Diana Wong had one vote, and Troy Nitsche had one vote. Sometime in 2000, John and Connie Aragona divorced and John Aragona left the state of Hawaii and also left the Hawaii LLC as a member. Nitsche TD1 49:25-50:10. Shortly thereafter, in 2001, Connie Aragona tried to extort the shrimp truck business from Troy Nitsche and she hired people to threaten Troy and his family at gunpoint if he did not sign over the business to her. Nitsche TD1 50:11-21; see also Answer at ¶¶ 5 and 6. Neither John

Aragona nor Connie Aragona ever contacted Mr. Nitsche, Mr. Goodrich, or anyone at the Hawaii LLC after their departures. Nitsche TD1 51:6-12; Nitsche TD1 55:9-56:14 (“Q. When was the first time John Aragona contacted you after he disappeared around 2000? A. The first – the first contact I had with John since I saw him walk out of the door of the bottling company was to receive a letter from an attorney. It was said to be representing him....Q. What is the date of the letter you received depicted at page 585? A. November 30, 2010”). The Hawaii LLC continued to operate after Registrant left. Nitsche TD1 82:7-18. The Hawaii LLC eventually dissolved. Nitsche TD1 88:2:5.

The GIOVANNI’S marks are well-known due to the extensive marketing and promotion, word of mouth and third-party articles and TV shows highlighting LuckyU’s use of the GIOVANNI’S marks. See PNOR Exhibit 3, LuckyU 00047-53, LuckyU 000136-37, LuckyU 000210-314, LuckyU 000317 – 400, LuckyU 001632, LuckyU 001633, LuckyU 001635, LuckyU 001642-46, LuckyU 002117-118, LuckyU 002127-128, JA000204-205, JA000206-209, JA000210-212, JA000415-423, JA000438-440, JA000442-445, JA 000450-456); see also Nitsche TD1 14:4-27:6; Nitsche TD1 Exs. 2 and 3). For example, LuckyU’s shrimp trucks are featured in Fodor’s Travel Guide and Frommer’s. See Nitsche TD1 32:25-34-7; Nitsche TD1 Ex. 7, LuckyU 001809-13; PNOR Ex. 3, LuckyU 001694-97. LuckyU’s shrimp trucks are also featured on the website “Hawaii for Visitors.” Nitsche TD1 34:12-17; Nitsche TD1 Ex. 7, LuckyU 001815. LuckyU runs a 30-second commercial sixteen times a day on the local hotel channel. Nitsche TD1 15:9-20; Nitsche TD1 at Ex. 2. LuckyU also has an advertisement in Spotlight Hawaii, Oahu Gold, 101 Things To Do On Oahu, among many other advertisements. Nitsche TD1 15:21-19; PNOR Ex. 3, LuckyU000137. LuckyU is also featured on blogs, including Buzzfeed. Nitsche TD1 at Ex. 7, LuckyU 001868-71; PNOR Ex. 3, LuckyU 001642-

46; Nitsche TD1 71:12-24. LuckyU is also featured on television shows, such as “Man versus Food,” “Real Housewives of Orange County,” “Ice Loves Cocoa,” and “Baywatch Hawaii.” Nitsche TD1 16:20-17:14. In addition to prior advertising efforts, LuckyU spent [REDACTED] on advertising from 2008-2013. Nitsche TD1 24:7-16. Prior to Nitsche’s purchase of the business there had not been any advertising by Connie and/or John Aragona. Nitsche TD1 25:4-6; [REDACTED]. LuckyU has steadily increased its annual revenue year over year and the company grossed in excess of [REDACTED] in 2013. Nitsche TD1 25:7-19.

B. Registrant is Not Affiliated With Any Company That Has Continuously Used the GIOVANNI’S mark

After Registrant sold his shrimp truck business to Mr. Nitsche, [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]. In October of 2000, Registrant left the state of Hawaii and was not heard from again until November 30, 2010. [REDACTED]; Nitsche TD1 55:9-65:14. [REDACTED]
[REDACTED]. During that ten year period, Registrant lived in various locations on the East Coast of the United States. PNOR Ex. 5, Registrant’s Objections and Responses to Petitioner’s First Set of Interrogatories, Interrogatory Response No. 12. Registrant has not been able to produce any evidence of sales or sufficient evidence to establish an intent to use the GIOVANNI’S marks during this period.

C. Registrant’s “Use” of the Trademarks Is Likely to Cause Confusion and Has Caused Confusion

Aragona has four registrations for trademarks that are likely to cause confusion and have caused confusion with LuckyU’s GIOVANNI’S marks. The four trademarks are entirely the same, or nearly the same as those used by LuckyU. For example, Aragona has a trademark

registration for GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK for "mobile restaurant services" in class 43, which is exactly the same mark for exactly the same services used by Petitioner. See PNOR at Ex. 1, Trademark Registration No. 4,232,569. Similarly, Aragona's other GIOVANNI'S trademarks are likely to cause confusion with Petitioner's use of Petitioner's GIOVANNI'S marks and have caused confusion.

a. **Similarity of the Marks**

Petitioner uses GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK, GIOVANNI'S SHRIMP TRUCK, and GIOVANNI'S ALOHA SHRIMP to promote its food retail related services. Nitsche TD1 9:11-16; Nitsche TD1 27:11-28:23; Nitsche TD1 61:10-63:5; Nitsche TD1 at Exs. 5 and 8 (identifying pictures found in Petition for Cancellation at p. 3). These services include selling shrimp plates prepared in a scampi or hot & spicy sauce. Nitsche TD1 9:20-25; Nitsche TD1 11:7-12:2; Nitsche TD1 64:6-25; Nitsche TD1 Ex. 8 (discussing Appendix E of Exhibit 8). Registrant applied for the marks "Giovanni's Original White Shrimp Truck," "Giovanni's Aloha Foods," "Giovanni's Scampi Marinade," and "Giovanni's Hot & Spicy We Really Mean IT! Sauce." See Petition for Cancellation. During prosecution of the "Giovanni's Original White Shrimp Truck registration, Registrant disclaimed "Original White Shrimp Truck." PNOR Exhibit 1. During prosecution of the Giovanni's Aloha Foods" registration, Registrant disclaimed "Foods." PNOR Exhibit 1. During prosecution of the "Giovanni's Scampi Marinade" registration, Registrant disclaimed "Scampi Marinade." PNOR Exhibit 1. During prosecution of the "Giovanni's Hot & Spicy We Really Mean It! Sauce" mark, Registrant disclaimed "Hot & Spicy" and "Sauce." The marks of both Petitioner and Registrant include the leading term GIOVANNI'S and Registrant considers the remainder of the marks as descriptive of the recited goods and services. It is clear the dominant portion of the respective marks is GIOVANNI'S and the marks as a whole share this term.

b. There is a Likelihood of Confusion and Ample Evidence of Actual Confusion

Petitioner operates a mobile food truck, providing retail food services including selling plates of shrimp in a scampi marinade or a hot and spicy sauce. Nitsche Dep. 9:20-25; Nitsche Dep. 11:7-12:2; Nitsche Dep. 64:6-25 (discussing Appendix E to Exhibit 8 of Nitsche Deposition). Registrant's goods and services are identical or nearly identical to Petitioner's services. For example, Registrant's "Giovanni's Original White Shrimp Truck" registration is for "mobile restaurant services." PNOR Exhibit 1. Registrant's "Giovanni's Aloha Foods" registration is for "food preparation services." PNOR Exhibit 1. Registrant's "Giovanni's Scampi Marinade" is for "marinades." PNOR Exhibit 1. Registrant's "Giovanni's Hot & Spicy We really Mean It! Sauce" is for "hot sauce." PNOR Exhibit 1.

Petitioner has been operating mobile food trucks and selling its retail food services, including plates of shrimp with scampi marinade and hot sauce since 1997 and has since become well-known. Nitsche TD1 60:17-22. Petitioner spends approximately [REDACTED] annually on advertising its services. Nitsche TD1 24:7-15. Petitioner's annual revenue is approximately [REDACTED] a year. Nitsche TD1. 25:7-15. When Petitioner first purchased the business the annual revenue was at best [REDACTED] a year. Nitsche TD1 25:22-26:4. The annual revenues have increased each year. Nitsche TD1 25:16-19. Petitioner attributes this rise in sales revenue to streamlining the business and focusing the business' notoriety. Nitsche TD1 26:5-18. As explained by Petitioner, the company worked to become a brand. Nitsche TD1 26:18. This notoriety is evidenced by the significant advertising and third-party recognition of the business addressed in Section A above.

Registrant has provided ample evidence of actual confusion by his customers. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Further, Petitioner has confirmed that certain customer emails received by Registrant are from confused customers. Nitsche TD1 57:8-25; Nitsche TD1 at Ex. 10. Registrant also encourages this confusion by placing customer reviews on his website that are describing Petitioner's business. See PNOR Exhibit 9, JA002600, JA002610, JA003006; Petition for Cancellation Exhibit C; Aragona TD at Ex. 29. Registrant's website also has a picture of Petitioner's shrimp truck and uses the slogans, "What began as an unknown shrimp truck on Oahu's North Shore – Became a Legend!" and "you no longer have to travel to Hawaii – to Get a Taste of Aloha." Registrant even admits that the use of the picture of the shrimp truck is to get people to buy his sauces. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]; Nitsche TD1 67:20-68:8; Nitsche TD1 at Ex. 14. Petitioner has also received confusing comments on its Facebook page. Nitsche TD1 70:14-71:11; Nitsche TD1 at Ex. 16, LuckyU002139.

c. Registrant Has Otherwise Abandoned the Trademarks

Registrant has not offered any evidence of use or an intent to resume use of the trademarks after he sold the business to Petitioner and/or he left the Hawaii LLC. Instead, Registrant left the State of Hawaii in 2000 and lived on the East Coast of the United States and he never again operated a food truck and he did not sell marinades or hot sauces for at least ten years. [REDACTED], PNOR Ex. 5, Interrogatory Response No. 12, Supplementary Interrogatory Response No. 5, Supplementary Interrogatory Response 9 (explaining that the only sales of sauces during this period were sales from the Hawaii LLC).

d. **Registrant's GIOVANNI'S marks Falsely Suggest a Connection with Petitioner and are Otherwise Deceptive.**

Registrant uses his Registered marks in a way that encourages confusion among customers. See PNOR Ex. 1 (Prosecution History of Giovanni's Aloha Foods Reg. 4,220,686 (specimen of use showing webpage picture of Petitioner's Shrimp Truck and stating "What began as an unknown shrimp truck on Oahu's North Shore – Became a Legend! You no longer have to travel to Hawaii – to Get a Taste of Aloha!)); Nitsche TD1 58:5-8; Nitsche TD1 at Ex. 11 ("Q. What is depicted in the upper right portion at Exhibit 11? A. That is the shrimp truck I bought"); Nitsche TD1 65:7-66:4; Nitsche TD1 at Ex. 8, Appendix C. Petitioner did not give Registrant permission to use a picture of its truck on the website. Nitsche TD1 58:24 – 59:2; Petition for Cancellation Exhibit C; Aragona TD at Ex. 29. [REDACTED]

[REDACTED]

[REDACTED].

Much of this evidence is addressed above and in connection with the facts associated with actual confusion, but Registrant's website is replete with references to Petitioner's business. Specifically, the website has a picture of the shrimp truck, two slogans referencing the shrimp truck and Hawaii, and customer reviews indicating the customers are referencing Petitioner's shrimp truck and not Registrant's marinade or hot sauce. There is ample evidence of Registrant's deceptive uses of Petitioner's trademarks.

e. **Registrant's Trademark Applications were Fraudulent**

Petitioner did not give Registrant permission to use pictures of the truck for Registrant's trademark applications. Nitsche TD1 68:9-12; Nitsche TD1 69:12-70:3. Petitioner filed trademark applications for similar marks well before Registrant, but Registrant filed a Letter of Protest against Petitioner's applications containing misleading information showing *Petitioner*

owned the marks, causing Office Actions to issue. Petitioner's failure to respond resulted in abandonment of the earlier applications. See PNOR Exhibit 2; Aragona TD 92:9-14. Despite knowledge of Petitioner's applications, Registrant filed trademark applications omitting any indication to the Trademark Office that Petitioner used the trademarks Registrant sought to register. Further, specimens of use for two of Registrant's registrations included pictures of Petitioner's shrimp truck. PNOR Exhibit 1, specimens of use for GIOVANNI'S ALOHA FOODS and GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK; Nitsche TD1 67:4-19; Nitsche TD1 at Ex. 14; Nitsche TD1 68:13-69:20; Nitsche TD1 at Ex. 15. The affirmative acts of providing fraudulent specimens and the omission of relevant ownership information are material misrepresentations of fact resulting in the fraudulent procurement of the Registrations.

V. **ARGUMENT**

A. **Petitioner's Long Use Establishes Its Priority and Standing**

The evidence establishes that Petitioner has been continuously using its GIOVANNI'S marks in relation to its retail food services, particularly plates of shrimp scampi and hot & spicy shrimp, dating from the time the shrimp truck business was purchased from Registrant and his wife in 1997 under the Asset Purchase Agreement. Petitioner's services are offered to customers throughout the United States and the world, and Petitioner's services are advertised to U.S. and Japanese consumers and any other visitors to the State of Hawaii. *See Interstate Commerce Issue - Larry Harmon Pictures Corp. v. Williams Rest. Corp.*, 929 F.2d 662, 664, 18 USPQ2d 1292 (Fed. Cir. 1991) (finding that it is not required that services be rendered in more than one state to satisfy the use in commerce requirement). Petitioner, as the successor in interest to Nitsche Enterprises, believes that it is being damaged by the registrations of Registrant's "Giovanni's" marks, believes there is a likelihood of confusion between its GIOVANNI'S marks and Registrant's "Giovanni's" marks, and has a real interest in this proceeding. This establishes

Petitioner's standing. Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 309.03(b) Petitioner had earlier filed trademark applications for its GIOVANNI'S marks, but the applications were abandoned for failure to respond to an Office Action after Registrant filed a Letter of Protest. Finally, Petitioner's trademark applications for GIOVANNI'S SHRIMP TRUCK and GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK have been provisionally refused due to Registrant's trademarks, pending the outcome of this proceeding.

a. Registrant Cannot Establish Priority Relying on Uses of the GIOVANNI'S marks by Unrelated Entities

It appears Registrant claims priority based on use by a company he sold and use by a company he was merely a member of long before the company dissolved. Priority based solely on use by entities not associated with Registrant is insufficient to establish priority. Registrant has not sold food at a mobile restaurant since the sale of his business in 1997. [REDACTED]

[REDACTED] Further, from 1997 until 2000 Registrant was merely a member of an LLC named Giovanni's Aloha Foods that bottled and sold scampi and hot sauce under the "Giovanni's" mark. Registrant left the LLC in 2000 and the LLC dissolved in 2004. Registrant cannot claim priority based on use by other entities. Thus, Registrant is unable to provide evidence of use establishing priority in any of the trademarks.

Registrant admits that since selling the business to Petitioner, the continued use in commerce is related only to use by LuckyU, Giovanni's Aloha Foods, a Hawaii LLC, and Nitsche Enterprises. [REDACTED]; see PNOR Exhibit 4, Registrants Admission No. 19 (Aragona admitted to not owning a food truck that provides mobile restaurant services); see PNOR Exhibit 5, Registrants Interrogatory Response No. 8 (showing bottling dates only from 2008), Registrant's Interrogatory Response no. 31 ("any

use by Petitioner is use that inures to the benefit of Respondent”), Registrant’s Interrogatory Response No. 35 (only food truck ever used for the registered services was truck sold to Petitioner); Registrant’s Interrogatory Response No. 36 (the only two trucks that offer “Registrant’s services” are Petitioner’s food trucks in Hawaii), Registrant’s Supplemental Interrogatory Response 36, Registrant’s Supplemental Interrogatory Response No. 6 (“As Registrant no longer has access to Giovanni’s Aloha Shrimp or Giovanni’s Aloha Foods, LLC business records, nor the information contained within them, the numbers included above are estimates provided to the extent of Registrant’s knowledge and based on information currently available to Registrant”), Registrant’s Supplemental Interrogatory Response No. 9 (“Registrant no longer has access to the information related to revenue from sales of hot sauce and marinades...Documents dating from 1994-1997 were transferred to Petitioner’s sole custody in 1997 when Petitioner took possession of the on-going shrimp truck business. Registrant has never had access to business records that would show information as to the revenue earned by Giovanni’s Aloha Shrimp from 1997 through present date”), Registrant’s Supplemental Interrogatory Response No. 38 (timeline demonstrating no contact with Petitioner or Petitioner’s predecessors-in-interest). Registrant sold the shrimp truck business to Nitsche Enterprises in 1997 to selling sauces. Once Aragona sold the shrimp truck business, he entered into an LLC agreement with his then wife, Connie, and Jim Goodrich and Diana Wong and formed Giovanni’s Aloha Foods. The investment included the Aragona’s shrimp sauce recipes and Goodrich and Wong’s business and legal expertise. Shortly thereafter, and in need of financial capital to sustain the business, Giovanni’s Aloha Foods offered Troy Nitsche a 25% share in the business in exchange for a \$100,000 investment. Mr. Nitsche accepted. Not long after Mr.

Nitsche joined the LLC, Registrant divorced Connie Aragona, left the LLC, and disappeared for another ten years.

Registrant has failed to provide any evidence of his use of the marks during the period after he sold his portion of the shrimp truck business to Nitsche Enterprises and after he left the Hawaii LLC in 2000. Registrant allegedly began selling sauces under the marks and operating as Giovanni's Aloha Foods, a Florida Corporation in 2010. Thus, use of the marks by the Florida Corporation in 2010, if any, is recent and does not predate LuckyU's use of the GIOVANNI'S trademarks. Any such use does not negate Petitioner's prior rights.

i. LuckyU, and its predecessors, are not related to Registrant

If Registrant is indeed claiming priority based on use, the claimed priority is improper. Registrant has failed to offer any evidence of direct control of the use of the mark by LuckyU or the Hawaii LLC. It is also well documented that Registrant, along with his then wife, sold his shrimp truck business and the assets thereto, including the trucks themselves and all signage and other means to run the business to Troy Nitsche. Once the assets were sold, Registrant did not maintain or exercise any control over Troy Nitsche, Nitsche Enterprises, or LuckyU Enterprises and there is nothing to contradict the signed "Asset Purchase Agreement." Further, as illustrated by the corporate documents and other evidence, Registrant was a member of Giovanni's Aloha Foods, LLC, a Hawaii Corporation, from its formation in 1997 until he left in 2000. The corporation bottled and sold shrimp scampi and hot & spicy sauces under GIOVANNI'S ALOHA FOODS, GIOVANNI'S SCAMPI SAUCE and GIOVANNI'S HOT & SPICY SAUCE trademarks. Long after Registrant left the business, the LLC continued to operate and use the various trademarks associated with the business. Registrant had no interaction with the company. It is also clear Registrant is claiming his priority dates based on use by these other companies. Section 5 of the Trademark Act of 1946 explains that legitimate use by *related*

companies (i.e., Nitsche Enterprises and Lucky U Enterprises) can inure to the benefit of a Registrant. See 15 U.S.C. § 1055. *However*, in order to be considered a “related company,” a Registrant must control the use of the mark by the related companies “with respect to the nature and quality of the goods or services in connection with the mark.” See 15 U.S.C. § 1127. There is no evidence that there was any agreement that Registrant could use the marks when he left the Hawaii Corporation or that he could continue the use of any goodwill in the marks when he left. There is also no evidence of Registrant’s control being exercised over the Hawaii LLC, Nitsche Enterprises, or LuckyU Enterprises. The use of the marks by these entities does not inure to the benefit of Registrant because Registrant and his company Giovanni’s Aloha Foods, a Florida Corporation are not “related companies” to Giovanni’s Aloha Foods, a Hawaii Corporation or LuckyU Enterprises. Registrant cannot claim priority based on this use.

ii. The Asset Purchase Agreement is Not a License

The Asset Purchase Agreement never uses the term license, but clearly is an agreement to sell a whole business. Moreover, it also uses the term “joint ownership” to explain the relationship between “buyer” and “seller” of one name, i.e., the “Giovanni’s Aloha Shrimp” tradename, rather than licensee/licensor. Registrant’s attorney drafted the Asset Purchase Agreement. If the intent of the parties was for the Asset Purchase Agreement to include a trademark license, that understanding must be set forth expressly in the contract. *See McCoy v. Mitsubishi Cutlery, Inc.*, 67 F.3d 917, 920, 36 USPQ2d 1289 (Fed. Cir. 1995) (“In most instances under contract law, a patent or trademark owner intentionally creates an express license”). Because there is no mention of a license agreement, the Asset Purchase Agreement should not be construed to provide rights to Aragona greater than that conveyed in the four

corners of the agreement. At best, the tradename “Giovanni’s Aloha Shrimp” was contemplated under the agreement to be jointly owned by the parties to the contract.

The portions of the agreement related to Nitsche Enterprises make it clear that a trademark “license” was not intended by the Asset Purchase Agreement. First, the non-competition clause states “[t]he terms of this Paragraph...the parties covenant and agree that without the existence of this clause that the buyer would not have entered into this Agreement.” The non-competition clause expressly states that Registrant and his then wife were prohibited from ever operating a lunch wagon in the State of Hawaii without the express written consent of the buyer. Second, section 21 expressly grants Nitsche Enterprise’s the right to use the name “Giovanni’s Aloha Shrimp” without any limitations. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Also absent from the agreement is any license term or quality control measures or right of inspection. The failure to include any of these terms and to exercise any control over the use of the mark all indicates that the asset purchase agreement was not, in fact, a license agreement.

iii. Registrant Never Exercised Control Over Petitioner or its Predecessor in Interest

There is no indication by the course of conduct between the parties that the agreement was a license agreement. None of the typical indicators of a license agreement are found in the Asset Purchase Agreement. Most importantly, there is no indication that Registrant ever exercised control over the quality of LuckyU’s products or services. As a general rule, a trademark license agreement requires “that the licensor exercise control over the quality of the goods which the licensee sells in connection with the mark.” *Haymaker Sports, Inc. v. Turian*,

581 F.2d 257, 264 (CCPA 1978). However, as Troy Nitsche explained, no one acting on Registrant's behalf as ever reviewed the quality of LuckyU's services. Nitsche TD1 52:24-53:2. The only mention in the agreement of any requirement on Nitsche Enterprises was to include 12 shrimp on each plate, which, as Mr. Nitsche explains, was indicative of the requirements contract entered into between the Aragona's and Nitsche Enterprises to spur volume sauce purchasing from the Aragona's. Nitsche TD1 46:11-18.

There are no license terms in the Asset Purchase Agreement. Further, LuckyU is not a related company to Registrant. The use of the marks by LuckyU Enterprises, therefore, does not inure to the benefit of Registrant.

B. Registrant's GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK Registration is *Void ab Initio*

Registrant filed a trademark application for GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK, claiming use as far back as 1994 based on specimens of use showing only Petitioner's mobile trucks and signs. Registrant admits that he has not sold a plate of shrimp since the 1997 food truck business sale to Petitioner. Yet Registrant's application claims a first use date of 1994 and use at least as of the application filing date of September 21, 2011. Because there is no license agreement between Petitioner or Petitioner's predecessor in interest, and Registrant, Registrant cannot claim priority based on Petitioner's use of the mark. Registrant's registration must be deemed *void ab initio*.

The Asset Purchase Agreement entered into between Nitsche Enterprises and John and Connie Aragona included a joint ownership between the parties over the tradename "Giovanni's Aloha Shrimp. The agreement provided for Petitioner to use "Giovanni's Aloha Shrimp" for selling plates of shrimp out of food trucks and John and Connie Aragona to use "Giovanni's Aloha Shrimp" for selling sauces. The agreement also mandated that Nitsche Enterprises would

purchase sauce made by Registrant and his then wife, as long as the sauces could be provided. Thus the sale of the shrimp truck business and joint ownership of the tradename did not provide Registrant any rights in the name GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK. Registrant's priority claim and subsequent claim of use of the trademark is not supported by the facts. The trademark registration for GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK is *void ab initio* because applicant had not used the mark on any of the goods or services identified in the application prior to the filing of the application. See *ShutEm Down Sports, Inc. v. Carl Dean Lucy*, 102 USPQ2d 1036, *11 (TTAB 2012).

The Asset Purchase Agreement assigned the entire food truck business to Nitsche Enterprises, including the mobile food trucks, the equipment to run the business, and even the signs advertising the business from the roadway. "When a business is sold as a going concern, trademarks and the good will of the business that they symbolize are presumed to pass with the sale of the business." J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 18:37. The only retained "asset" was the right by Registrant and his wife, along with Nitsche Enterprises, to jointly own the state trade name "Giovanni's Aloha Shrimp." There is no ambiguity that all of the food truck assets transferred to Nitsche Enterprises, including the rights to use the trade name "Giovanni's Aloha Shrimp" with the shrimp truck business. Further, there is no ambiguity as to whether the trademarks GIOVANNI'S SHRIMP TRUCK or GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK were part of the Asset Purchase Agreement, they were not. Petitioner purchased all of the shrimp truck assets and there is absolutely no mention of the GIOVANNI'S SHRIMP TRUCK or GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK in the Asset Purchase Agreement. Further, Registrant never referenced the business as GIOVANNI'S ORIGINITAL WHITE SHRIMP TRUCK or

GIOVANNI'S SHRIMP TRUCK.⁸ These marks were first used by Petitioner after Nitsche Enterprises purchased the business. Nitsche TD1 10:3-24; Nitsche TD1. 59:12-16; Nitsche TD1 74:4-22. Thus to the extent Registrant claims any rights in the mark GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK, he either never had rights in that trademark or he sold all rights in the name along with the sale to Nitsche enterprises in 1997.

Thus, the trademark registration for GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK is *void ab initio*.⁹

C. Registrant's Marks Are Likely to Cause Confusion and have Caused Confusion with Petitioner

Registrant's GIOVANNI'S marks are confusingly similar to Petitioner's GIOVANNI'S marks because: 1) The marks are identical and/or nearly identical because GIOVANNI'S is a common leading component; 2) the goods are identical and/or closely related; 3) there is significant evidence of actual confusion; and 4) Respondent intentionally adopted its identical and/or similar mark.

The factors relevant to the analysis of likelihood of confusion between two marks were established in *In re E.I. DuPont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973). These factors include the similarity or dissimilarity of the marks in their entireties; the similarities or dissimilarities of the goods or services; the similarity or dissimilarity of established, likely-to-continue trade channels; the conditions under which buyers to whom sales are made; the fame or strength of the prior mark; the number and nature of similar marks in use on similar goods; the nature and extent of any actual confusion; the variety of goods on which a mark is used or not

⁸ Registrant called the shrimp truck business "Giovanni's Aloha Shrimp." It was only after Petitioner purchased the business that Nitsche Enterprises started using GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK and GIOVANNI'S SHRIMP TRUCK.

⁹ For at least this reason, this registration should also be cancelled for non-use, abandonment, and fraud.

used; the market interface between applicant and the owner of a prior mark, including laches and estoppel attributable to owner of prior mark and which is indicative of confusion; the extent to which applicant has a right to exclude others from use of its mark on its goods; the extent of potential confusion; and any other established fact probative of the effect of use. *Id.* at 567. These factors, which establish likelihood of confusion with Registrant's GIOVANNI'S marks, are discussed below.

a. **The marks as a whole are identical and/or highly similar because each mark begins with GIOVANNI'S**

Registrant has registered the mark GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK, which is the exact mark used by Petitioner. Similarly, Registrant has registered three other marks that begin with the term GIOVANNI'S. The Trademark Trial and Appeal Board (TTAB) has determined that consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark. *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (stating "it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decision); *see Palm Bay Imps., Inc. v. Veuve Cliquot Pnsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); *Mattel Inc. v. Funline Merch Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006). The dominance of the identical leading term GIOVANNI'S is supported by the evidence of confused customers, discussed below.

Registrant has disclaimed almost every portion of his marks apart from GIOVANNI'S indicating he believes the remainder of the marks are descriptive but for the GIOVANNI'S portion. Matter that is descriptive of or generic for a registrant's goods is typically less significant in relation to other wording in a mark. *See In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004); *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB

2009). For example, the GIOVANNI'S SCAMPI MARINADE registration disclaims "scampi marinade." The GIOVANNI'S HOT & SPICY WE REALLY MEAN IT!! SAUCE registration disclaims "hot & spicy" and "sauce."¹⁰ The GIOVANNI'S ALOHA FOODS registration disclaims "foods." Thus, according to Registrant, GIOVANNI'S is the only distinctive portion of his marks.

Petitioner also prominently uses GIOVANNI'S in branding and has done so since acquiring all rights to the shrimp truck business. Petitioner also calls its dishes Giovanni's Scampi and Giovanni's Hot & Spicy and uses the trademark GIOVANNI'S ALOHA SHRIMP. Thus, Registrant's marks are nearly identical to Petitioner's marks in appearance, sound, meaning, and commercial impression, all of which indicates there is a likelihood of confusion.

b. The Goods and Services Are Essentially the Same and/or Within the Zone of Natural Expansion

Both Petitioner and Registrant sell shrimp and/or shrimp related products. Although Registrant has admitted he has not sold food out of a mobile food truck, the registration for GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK indicates exactly such services. Petitioner sells shrimp scampi and shrimp with hot & spicy sauce out of a mobile food truck. Registrant, similarly, purports to sell shrimp scampi marinade and a hot sauce and has registered trademarks for these same goods. Not only are Registrant's goods and services identical and/or closely related to Petitioner's goods and services, but marinades and hot sauces are clearly within Petitioner's zone of natural expansion. See Trademark Trial and Appeal Board Decision in Serial No. 75,894,470 (finding that "steak sauce and barbeque sauce" is related to "restaurant and pub services").

¹⁰ The specimen shows the GIOVANNI'S HOT & SPICY WE REALLY MEAN IT! SAUCE mark fails to function as a trademark under §§ 1, 2 and 45, but that has not been separately alleged.

Because the goods and services at issue are identical and/or closely related, this DuPont factor clearly supports a finding of likelihood of confusion.

c. Petitioner Has Strong Brand Recognition and is Well-Known for Shrimp

The GIOVANNI'S mark is strong in relation to the sale of shrimp and shrimp related products. Petitioner is well known in this marketplace for these products under these marks. Petitioner spends significant amounts on advertising in Hawaii, a tourist destination, and specifically targets visitors to Oahu, and has been featured on worldwide television shows, third party articles and internet blogs.

The advertising includes GIOVANNI'S and often a picture of the White Shrimp Truck. Petitioner spends more than [REDACTED] annually on advertising. Nitsche TD1 24:7-15. Petitioner's sales are also significant. Sales under the GIOVANNI'S brand are in the millions of dollars a year, all from selling plates of shrimp at two shrimp truck locations.

Sales have steadily increased since Petitioner purchased the trucks in 1997. Nitsche TD1 25:22-4. Due to the extensive advertising by Petitioner, this increase in sales has led to worldwide recognition. [REDACTED]

[REDACTED]

[REDACTED]

The numerous third party articles discussing Petitioner's food also indicate its status as a well-known brand for food retail and especially the sale of shrimp and shrimp related products. For example, there are numerous articles written in The Honolulu Advertiser and The Star Bulletin that reference Petitioner. PNOR Ex. 3, JA000204-212, JA000296-303, JA000415-423, JA000438-445. The Honolulu Magazine, Hawaii Marine Lifestyles, and The Business Journals

have also written articles referencing Petitioner. PNOR Ex. 3, JA000450-455, LuckyU 000047-53.

d. There is Significant Evidence of Actual Confusion

There is significant evidence that customers are actually confused between Petitioner's GIOVANNI'S marks and Registrant's GIOVANNI'S marks. In a typical case, there is difficulty in obtaining evidence of actual confusion. The Board and the courts have frequently acknowledged that evidence of actual confusion is difficult to adduce, and, for this reason, a few incidents of confusion are highly probative of the likelihood of confusion. *See Plus Products v. Physicians Formula Cosmetics, Inc.*, 198 USPQ 111, 114 (TTAB 1978) (stating that "[e]vidence of actual confusion is neither easy to come by nor necessary to show that likelihood of confusion exists"); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975) (stating that a "single instance of confusion is at least 'illustrative of a situation showing how and why confusion is likely'"). Not only is there evidence of actual confusion, but Registrant actively invites confusion through his interaction with customers. It is clear that under such circumstances, the amount of evidence is especially significant.

Even though actual confusion is not necessary to establish likelihood of confusion, "[a]ny evidence of actual confusion is strong proof of the fact of a likelihood of confusion." J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:13. In fact, the best evidence of likelihood of confusion is provided by evidence of actual confusion. *See In re Majestic Distilling Co.*, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) (stating that a "showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion").

██████ This is all evidence of actual confusion. *See Edgecraft Corporation v. Smiths Consumer Products, Inc.*, CANCELLATION 9205294, 2013 WL 5407302, at *11 (TTAB 2013) (finding that the nature of the declarant's questions were probative of actual confusion).

Registrant also encourages this confusion by placing customer reviews on a that indicate some relation to Petitioner's business. [REDACTED]

There are numerous instances of actual confusion between the use of the marks, all based on Registrant's intent to instill confusion.

e. **There was Little or No Period of Concurrent Use Without Evidence of Actual Confusion**

Confusion resulted as soon as Registrant used the marks in the marketplace for sauces, only to expand in frequency. Registrant admits to forming Giovanni's Aloha Foods, a Florida Corporation and purportedly making some sauce sales in 2009 or 2010. See Aragona TD at Ex. 30. Registrant's customer emails indicate confusion as early as January 17, 2011. See Nitsche TD1 at Ex. 10. This is not a case of two marks coexisting in the marketplace, side by side, for many years with no reported instances of confusion. Rather, there have been numerous instances of actual confusion in a short time. Especially given the difficulty of discovering such evidence, this indicates there was little to no period of concurrent use of Petitioner's and Registrant's marks without actual confusion and this factor strongly supports the likelihood of confusion.

f. **Registrant Intentionally Adopted Marks identical to and/or Similar to Petitioner's Marks.**

Registrant intentionally adopted identical and/or confusingly similar marks to Petitioner's marks in order to trade off of the significant goodwill Petitioner has developed in its marks over the past 18 years.

"It is well established that intent of the alleged infringer to gain through confusing customers or others is relevant to the issue of likelihood of confusion." J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:110 (citing to *Lever Bros. Co. v. Riodela Chemical Co.*, 5 USPQ 152 (CCPA 1930) ("[W]e have a right in determining the question of likelihood of confusion or mistake, to consider the motive in adopting the mark as indicating an opinion, upon the part of one vitally interested, that confusion or mistake would likely result from use of the mark")). If a plaintiff can show that a defendant adopted a mark with the intent to cause confusion or to deceive, that can "justify an inference that confusion is likely." RESTATEMENT THIRD, UNFAIR COMPETITION § 22, COMMENT C (1995); *Freedom Card, Inc. v. JP Morgan Chase & Co.*, 77 USQP2d 1515 (3rd Cir. 2005) (stating that "[i]n a direct confusion case, the defendant's intent to confuse or deceive consumers can be very probative of the likelihood of confusion"). Where one tries to create an association, it can be presumed that one will succeed in doing so and this factor weighs in favor of finding a likelihood of confusion.

Registrant was always aware of Petitioner and the use of Petitioner's marks. The record establishes that Registrant sold Petitioner's predecessor a food truck business and also that he was involved in a joint venture with the members of Petitioner in another business. The joint business was entitled GIOVANNI'S ALOHA FOODS. Registrant, after leaving the business, later named his new business and registered a trademark for the same exact name, GIOVANNI'S ALOHA FOODS. Registrant, anticipating a challenge from Petitioner, sent Petitioner a letter

advising Petitioner of an intent to adopt similar trademarks in direct competition with Petitioner's business. See Nitsche TD1 at Ex. 14. Registrant also filed a Letter of Protest with the U.S. Patent and Trademark Office claiming Petitioner's rights and generating Office Actions issued to Petitioner's first trademark applications. Registrant was well aware of Petitioner's rights in the trademark and still adopted the identical and nearly identical trademarks in hopes of trading off of Petitioner's goodwill.

All of this evidence points directly to an intent to cause confusion, and in fact, actual confusion resulted between Petitioner's use of its marks and that of Registrant.

D. If Registrant Ever Had Any Rights in the Trademarks, Any Rights Are Abandoned

Although Registrant has never himself had rights in any of the trademarks since selling the business in 1997, to the extent he claims to have used the marks before Petitioner he always used the marks in conjunction with: 1) his then wife; and 2) Giovanni's Aloha Foods, LLC, a Hawaii Corporation. Registrant never acquired trademark rights on his own to any GIOVANNI'S formative marks. Further, Registrant and his then wife, together sold the shrimp truck business to Petitioner's predecessor, Nitsche Enterprises. Similarly, Registrant was a member of Giovanni's Aloha Foods, LLC, a Hawaii Corporation, and any use during that time was attributed to the membership, and not to Registrant. However, to the extent Registrant claims he had separate rights in the marks, he abandoned the marks.

a. By Leaving Giovanni's Aloha Foods, Registrant Abandoned Any Claim to Trademark Rights in the Marks

Registrant abruptly withdrew from Giovanni's Aloha Foods, LLC in 2000 and only started his own "Giovanni's Aloha Foods, LLC" in 2010. See Aragona TD at Ex. 30. His abrupt departure from the membership at least constituted a cessation of use with an intent not to resume such use. See 15 U.S.C. § 1127. Registrant never contested the Hawaii LLC's use of the

trademarks following his withdrawal from the company. Registrant did not contest the dissolution and asset apportionment when the company dissolved in 2004. Registrant did not receive any disbursement from the company after he withdrew and he never requested a disbursement. All of these facts confirm Registrant knew he had no rights, but, at a minimum, to the extent Registrant had any claim to a right to use the trademarks, he abandoned those claims when he withdrew from the now-dissolved Hawaii LLC.

b. There is a Presumption of Abandonment

If Registrant has any personal claim to the trademark rights, his failure to use the rights for a ten year period constitutes nonuse and is prima facie evidence of abandonment. See 15 U.S.C. § 1127 (“nonuse for three consecutive years shall be prima facie abandonment”). The burden to prove use or an intent not to abandon the marks then falls to Registrant. Use requires more than mere token use. Use of a mark means the bona fide use of such mark in the ordinary course of trade. *See Cumulus Media, Inc. v. Clear Channel Communications, Inc.*, 304 F.3d 1167 (11th Cir. 2002). Registrant has not provided any evidence of use or intent not to abandon use. Instead, he has only offered his self-serving testimony to try to “reclaim” the trademarks, yet there is no corroborating evidence. Thus, Registrant has abandoned the marks.

E. Registrant’s Registration and Use of Registrant’s GIOVANNI’S marks Suggests a False Connection with Petitioner

Registrant not only adopted similar names to those in use by Petitioner, but he adopted the exact same names used by the Hawaii LLC, which is associated with Petitioner. Registrant not only adopted similar trademarks but he also uses representations of Petitioner’s shrimp truck to boost the false connection. This is evidenced by Registrant’s representation of Petitioner’s shrimp truck on a website and also as a supporting application specimen of use.

It is unnecessary to reiterate the identical nature of the mark in Registrant's registration for GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK, which is not even in use by Registrant. However, Registrant's other trademarks fall squarely under the provisions of 15 U.S.C. § 1052(a) because of the clear intention to associate his use of the marks with that of Petitioner. *See Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 1377, 217 USPQ 505 (Fed. Cir. 1983). Under 15 U.S.C. § 1052, a registered trademark cannot consist of or be comprised of matter which falsely suggests a connection with a corporation. *See In re Wielinski*, 49 USPQ2d 1754 (TTAB 1998) (discussing that this section applies to corporations) (overruled on other grounds). There are four elements confirming the false connection: (1) that the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution; (2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution; (3) the person or institution named by the mark is not connected with the activities performed by the applicant under the mark; and (4) the fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed. It is unmistakable that Registrant's adoption and use of the marks are aimed at identifying Petitioner and its predecessor company, the Hawaii Corporation and thus Registrant's use and registration suggests a false connection with Petitioner.

Unlike in *Notre Dame*, there is plenty of evidence to establish an intent on the part of Registrant to identify Petitioner. *See Notre Dame*, 703 F.2d at 1377. Not only does Registrant's website have a picture of Petitioner's shrimp truck, but the specimen of use for the GIOVANNI'S ALOHA FOODS trademark application also shows use of Petitioner's shrimp truck. Further, Registrant's website has a section of "customer" quotes that are clearly and

unequivocally describing Petitioner's goods and services. See Nitsche TD1 at Ex. 8, Appendix C ("Our friend told us to stop at the 'White Shrimp Truck' in Kahuka and we're glad we did!...Thanks for serving some of Oahu's finest, tastiest, freshest shrimp scampi...I'm a shrimp truck addict for 12 years – nothing but Giovanni's! I didn't eat at the truck the first time I saw it (2000)"). Registrant is also located in Florida, yet he has named his company "Giovanni's Aloha Foods" which creates an impression that the company is associated with the State of Hawaii, where Petitioner conducts its business and is known to do so by customers. Registrant was a former member of the Hawaiian Corporation, yet he has now registered the same trademarks used by that company to sell his sauces. This has caused considerable confusion as described above. Registrant's registrations falsely suggest a connection with Petitioner.

F. Registrant's Website Evidences Registrant's Deceptiveness

Registrant's use of his marks misrepresents the source and further indicates the deceptiveness of the registrations, confirming the marks should be cancelled under 15 U.S.C. § 1052(a). Under this section, the marks should be cancelled because Registrant deliberately misrepresented that his sauces originate from Petitioner when in fact they do not. *See Otto Int'l, Inc.*, 83 USPQ2d 1861, 1863 (TTAB 2007). Registrant took numerous steps to deliberately pass off its goods as those of LuckyU in a blatant manner calculated to trade on the goodwill and reputation of Petitioner. *Id.*

It is indisputable that Registrant was aware of Petitioner's shrimp truck business and the use of Petitioner's trademarks when he applied to register the trademarks at issue. Registrant, along with his ex-wife, sold to Petitioner the shrimp truck business, including the trucks and equipment. John and Connie Aragona were well aware they sold those rights, as illustrated by the assault by Connie Aragona to try to "reclaim" the rights once Petitioner's predecessor company was turning the shrimp truck business into a successful business. Registrant even put

Petitioner on notice that he was planning to begin selling his sauces under the GIOVANNI'S mark and, seemingly understanding that Petitioner would object, asked that Petitioner register any complaints well before Registrant applied to register the trademarks. Nitsche TD1 at Ex. 10, JA000585. Petitioner then applied for its own trademark registrations and Registrant filed a Letter of Protest. See Nitsche TD2 at Ex. 15A, Office Action issued to Petitioner's original trademark application for GIOVANNI'S ORIGINAL WHITE SHRIMP TRUCK. [REDACTED]

[REDACTED]

[REDACTED] There is no dispute that Registrant was aware of Petitioner and Petitioner's use of the trademarks.

With the knowledge of Petitioner's use in hand, Registrant went beyond just registering the trademarks, Registrant also used a picture of Petitioner's shrimp truck on his website and memorialized customer reviews of the shrimp truck as if the reviews were his own. See PNOR Ex. 1 (Prosecution History of Giovanni's Aloha Foods Reg. 4,220,686 (specimen of use showing webpage picture of Petitioner's Shrimp Truck and stating "What began as an unknown shrimp truck on Oahu's North Shore – Became a Legend! You no longer have to travel to Hawaii – to Get a Taste of Aloha!)); Nitsche TD1 58:5-8; Nitsche TD1 at Ex. 11 ("Q. What is depicted in the upper right portion at Exhibit 11? A. That is the shrimp truck I bought"); Nitsche TD1 65:7-66:4; Nitsche TD1 at Ex. 8, Appendix C. Petitioner did not give Registrant permission to use a picture of its truck on the website. Nitsche TD1 58:24 – 59:2; Petition for Cancellation Exhibit C; Aragona TD at Ex. 29. "The function of a trademark is to identify a single, albeit anonymous, source of commercial sponsorship of the goods to which it pertains." *Johnson & Johnson v. E.I. du Pont de Nemours & Co.*, 181 USPQ 790, 791 (TTAB 1974). Thus, even if the website does not specifically name Petitioner or its trademarks, Registrant achieves the same result by copying

Petitioner's distinctive shrimp truck and providing customer reviews that indicate an association with Petitioner. [REDACTED]

[REDACTED]. These specific acts by Registrant were "aimed at deceiving the public into thinking that [Registrant's] goods actually emanate from Petitioner" and thus the registrations should be cancelled. *Otto*, 83 USPQ2d at 1864.

G. Registrant's Fraudulent Prosecution of the Applications Deceived the PTO

Registrant's procurement of the trademark registrations is the epitome of fraud. Not only was Registrant aware of Petitioner's claim to the trademarks, Registrant filed specimens of use depicting the marks in use on Petitioner's shrimp trucks. Filing false specimens of use and/or claiming ownership of another entity's mark is a false, material misrepresentation of fact necessitating cancellation of the trademark registrations.

To prove fraud, there must be clear and convincing evidence that an Applicant knowingly made a false, material representation of fact in connection with his application with an intent to deceive the PTO. *In re Bose*, 580 F.3d 1240, 1245, 91 USPQ2d 1938 (Fed Cir. 2009). Registrant's conduct in procuring the registrations with specimens of Petitioner's usage more than satisfies the clear and convincing evidence standard, showing a subjective intent to deceive the PTO.

Registrant submitted pictures of Petitioner's use of the marks in order to demonstrate use to the Trademark Office. "An Applicant's statements as to its use of a mark for particular goods and services are unquestionably material to registrability." *Nationstar Mortgage LLC*, 112 U.S.P.Q.2d 1361, *3 (TTAB 2014). "Averments and evidence of use of a mark for the goods or services identified in a use-based application are critical to the approval of a use-based application, and if it were disclosed to the examining attorney that the mark was not in use for

the identified services (or that the identified specimen was fabricated), registration would have been refused.” *Id.* at *4. Registrant’s submission of Petitioner’s use of the marks as specimens of use, a requirement for registrability, establishes materiality.

Registrant also claimed ownership of the marks despite Petitioner’s ongoing use of the marks and Petitioner’s denial of Registrant’s claim to any rights in the marks. Registrant willfully withheld this information from the trademark examining attorney during all facets of the prosecution of the applications. The application declarations were signed wherein Registrant claimed he owned the marks and knew of no one else with a right to use the marks. Willfully withholding this ownership information was a material, false misrepresentation of fact, and thus fraudulent. *See Kelly Services Inc. v. Greene’s Temporaries Inc.*, 25 USPQ2d 1460, 1462 (TTAB 1992).

The Board has noted that “there are limits to what may be claimed in good faith.” *Id.* at *13. [REDACTED]

[REDACTED] However, in order to obtain registrations for these services, Registrant filed specimens of use showing Petitioner’s use of the marks. See PNOR at Ex. 1 (Specimens of Use to Registration Nos. 4,220,686 (GIOVANNI’S ALOHA FOODS) and 4,232,569 (GIOVANNI’S ORIGINAL WHITE SHRIMP TRUCK)); Nitsche TD1 61:19-64:25; Nitsche TD1 at Ex. 8. Registrant submitted these specimens without the permission of Petitioner and knowing that Petitioner did not consider such use to inure to Registrant. Registrant also did not notify the trademark examining attorney that the claimed use was by an unrelated entity and that the entity was contesting Registrant’s right to the trademarks. The specimen submissions illustrate Petitioner’s use of the trademarks, yet Registrant misrepresents such use as his own. At a

minimum, the circumstances corroborate that false information was provided to the Trademark Office and some information was withheld by Registrant's attorney when she signed the declaration.¹¹ The withholding of proper ownership information was fraudulent and the registrations should be cancelled for these reasons.

VI. CONCLUSION

For the foregoing reasons, Petitioner requests cancellation of Trademark Registration Nos. 4,220,686, 4,232,569, 4,248,595, and 4,224,400.

Respectfully Submitted,

LuckyU Enterprises dba Giovanni's Original White
Shrimp Truck

Date: March 16, 2015

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¹¹ Counsel for Registrant resisted a deposition, despite being the declarant to the applications. However, Registrant stipulated that all information in the applications was provided by John Aragona. PNOR Ex. 8 (TTABVue #15).

CERTIFICATE OF SERVICE

I hereby certify that on this 16th day of March 2015 a true and correct copy of the foregoing **PETITIONER'S BRIEF** was served on Respondent's Counsel, Jamie N. Pitts., The Law Office of Jamie N. Pitts, Esq., 887 W. Marietta Street, NW, Ste. M-105, Atlanta, GA 30318, via First Class Mail, with a courtesy copy served via e-mail to jamienpitts@jnplawfirm.com.

s/Daniel Mullarkey/

Daniel Mullarkey